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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,825	06/12/2001	Craig W. Barnett	23419-003-409	4591

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MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC  
12010 SUNSET HILLS ROAD  
SUITE 900  
RESTON, VA 20190

EXAMINER
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DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/879,825

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Claims 47-62 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 9/12/03 is insufficient to overcome Nichtberger and Valencia references.

### ***Interference***

3. Applicant's provocation of an Interference with Patent 6,076,069 has been noted. However, claims 47-62 are rejected as stated below. Therefore, an Interference has not been initiated.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 52 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 52 discloses a TCP/IP network. However, nowhere in applicants specification is a TCP/IP network explicitly disclosed.

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Additionally, the claim is broader in scope than the specification. A TCP/IP network is broader than the Internet. Because TCP/IP is a protocol, there are TCP/IP based networks which are not part of the Internet. Hence, a TCP/IP network is broader than the Internet which is one manifestation of a TCP/IP network.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 47-51 and 53-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger (4,882,675) in view of Valencia (5,380,991).

Claims 47, 57: Nichtberger discloses a system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a client system, said first server system being adapted for transmitting an electronic coupon to said client system over said communications channel (col 5, lines 1-16; col 11, lines 40-50; col 30, lines 1-6);  
said client system including associated memory, said client system being adapted for storing said electronic coupon in said memory (col 30, lines 1-6);  
a second server system connected to said communications channel, said second server

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system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system, said second server system further being adapted to redeem said electronic coupon (col 30, lines 1-6).

Nichtberger further discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

Claim 48, 59: Nichtberger and Valencia disclose a system according to claim 47, 57, Nichtberger further discloses:

a third server system connected to said communications channel, said third server system being adapted for communicating with said second server system and for authorizing the redemption of said electronic coupon (Fig. 4; col 17, lines 49-60).

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Claim 49: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon as a function of a transaction initiated between said client system and said second server system (Fig. 4).

Claim 50: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said second server system is adapted to redeem said coupon by modifying a transaction initiated between said client system and said second server system (Fig. 4).

Claim 51: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said communications channel includes a network (Fig. 1; col 15, lines 25-30; col 12, lines 8-15).

Claim 53: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said first server system and said second server system are the same server system (col 5, lines 1-5).

Claim 54: Nichtberger and Valencia disclose a system according to claim 47, and Nichtberger further discloses that said electronic coupon is a token issued under the authority of an issuer for the benefit of said client (col 30, lines 17-30).

Claim 55: Nichtberger and Valencia disclose the system according to claim 47, and Nichtberger further discloses that said electronic coupon includes data representative of one or more of a serial or identification number, a validation key, an authentication key, an authorizing vendor, a redeeming vendor, a benefit or discount to be associated with a transaction, a level of access granted, and an issuing activity (col 30, lines 17-30; col 19, lines 34-39; col 22, lines 1-9).

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Claim 56: Nichtberger and Valencia disclose the system according to claim 47, and Nichtberger further discloses that said electronic coupon includes data representative of the identity of a location at which additional coupon information resides (col 30, lines 24-30).

Claim 58: Nichtberger and Valencia disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Nichtberger further discloses that prior to step A, the server receives a request for information from the client (col 5, lines 3-8; col 10, line 65-col 11, line 5).

Claim 60: Nichtberger and Valencia disclose a method of distributing and redeeming an electronic coupon according to claim 57, and Nichtberger further discloses the steps of establishing a connection between said subsequent server and an authentication server; said authentication server authenticating said electronic coupon and authorizing the redemption of said electronic coupon (Fig. 4; col 17, lines 49-60; col 11, lines 40-45).

6. Claim 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger (4,882,675) in view of Valencia (5,380,991) and in further view of Cameron (5,592,378).

Claim 52: Nichtberger and Valencia disclose a system according to claim 47. Nichtberger further discloses that the coupon includes a data component (col 19, lines 34-39; col 22, lines 1-9), that the communications channel operates over a network which can be expansive and operate over remote areas (col 32, lines 1-8; Fig. 1; col 15, lines 25-30; col 12, lines 8-15).

Nichtberger does not explicitly disclose that the network is TCP/IP based.

However, Cameron discloses redeeming coupons over a network that operated over remote areas that utilizes a TCP/IP based network (col 5, lines 13-16; col 11, lines 10-15).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Cameron's TCP/IP based network to Nichtberger's network operating over a remote area. One would have been motivated to do this because TCP/IP is a standard and effective protocol for a network operating over remote areas.

7. Claims 47, 57, 61, and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,227,874).

Claims 47, 57, 61, and 62: Von Kohorn discloses a system for distributing and redeeming electronic coupons comprising:

a first server system including a computer processor and associated memory, said first server system being connected by a communications channel to a remote client system, said first server system being adapted for transmitting an electronic coupon to said remote client system over said communications channel (col 74, lines 33-40; col 16, lines 30-40; col 19, lines 20-39; Fig. 29, item 904; col 94, lines 35-41; col 95, lines 5-10; col 32, lines 47-55; col 45, lines 41-44); said remote client system including a computer processor and associated memory, said remote client system being adapted for storing said electronic coupon in said memory (Fig. 30; col 14, lines 20-25; Fig. 26; Fig. 27; Fig. 4);

a second server system connected to said communications channel, said second server system being adapted to establish a connection with said remote client system (col 88, lines 29-55) and for detecting said electronic coupon stored on said remote client system (col 3, lines 3-22), said second server system further being adapted to redeem said coupon (col 87, lines 55-66).

Von Von Kohorn does not explicitly disclose that electronic coupon is electronically transmitted redemption.



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However, Von Kohorn discloses redeeming incentives in a variety of manners including over the phone (col 87, lines 55-66; col 82, lines 40-45), the electronic transfer of incentive information to redemption centers (col 40, lines 10-15); and that there is an electronics communication between the client system and the server system (col 88, lines 29-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information to Von Kohorn's varied manners of redeeming incentives. One would have been motivated to do this so that Von Kohorn's users have an additional and convenient way of redeeming incentives.

Also, note that the claims do not state the first server system and second server systems are different server systems. Hence, the first and second server systems could be the same server systems or different server systems. In fact, claim 53 of the Applicant's claim explicitly discloses that the first and second server systems can be the same server system.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 47-60 have been considered but are not found persuasive.

Applicant's arguments with respect to claims 61, 62 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

In regards to arguments in the Amendment dated 9/12/03 concerning the U.S.C. 112 rejection, the claim is broader in scope than the specification. A TCP/IP network is broader than

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the Internet. Because TCP/IP is a protocol, there are TCP/IP based networks which are not part of the Internet. Hence, a TCP/IP network is broader than the Internet which is one manifestation of a TCP/IP network.

In regards to Applicant's arguments in the Amendment dated 9/12/03 concerning the U.S.C. 103 rejection, Examiner notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art.

Hence, in claims 47 and 57-51, the Applicant states, 'said client system including a computer processor and associated memory'. Whether the client system is a Personal Digital Assistant, personal computer, mainframe, laptop, or other form of client system is irrelevant as the claims make no statement as to the type of client system. The claims do state that the client system must have a computer processor and associated memory. And, the Valencia reference clearly discloses a client system, in the form of a smart card, with a computer processor *and* associated memory. Additionally, the Applicant's amendment on page 11 states that a Smart Card, 'contains electronic memory. . .an embedded integrated circuit. . .storing. . .records. . .generating network Ids'. Hence, the specification of Valencia discloses the features of the Applicant's client system as stated in the Applicant's claims.

In regards to arguments made on page 13 of the Applicant's amendment, Applicant states, 'Nichtberger/Valencia fail to teach the first server system being adapted for transmitting an electronic coupon to said client system over said communications channel, and the client system being adapted for storing said electronic coupon in said memory.'

However, Nichtberger (col 30, lines 1-6) and Valencia (col 7, lines 41-49) clearly discloses that the client system stores electronic coupon in said memory.

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Additionally, in Nichtberger (col 30, lines 1-6) it is inherent that the coupon information in the first server system is transmitted to the client system, which is the card. That the coupon information is transmitted is inherent because the coupon information is stored electronically on both the first server system and the client system. And, the information is 'recorded' on the second client system. Hence, the information must be transmitted in order to be recorded in a device where the information had not been.

In regards to arguments made on page 14 of the Applicant's amendment, Applicant states, 'Nichtberger/Valencia fail to teach a second server system connected to the communications channel'.

However, Nichtberger clearly discloses that there are multiple server systems that interact with the client system for coupon distribution and redemption (Fig. 1, item 10; Col 4, lines 41-47). Hence, the user utilizing the client system can be transmitted coupons at one location by a first server system and redeem coupons at a different location by a second or different server system.

In regards to the combination of Nichtberger and Valencia, Nichtberger discloses that the card for storing coupon information is special (col 10, line 65-col 11, line 5).

Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory.

However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47).

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Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia's smart card to Nichtberger's special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

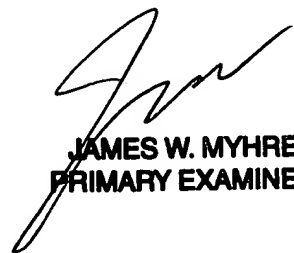
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AD

10/6/03

  
**JAMES W. MYHRE**  
**PRIMARY EXAMINER**